

REMARKS

As a preliminary matter, Applicants thank the Examiner for the allowance of claims 6 and 7, as well as the acknowledgement of allowable subject matter in claim 5.

Claims 1, 3-4, and 8-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ekhoﬀ (U.S. 6,097,568). Applicants respectfully traverse this rejection as follows.

With respect to claim 1 of the present invention (and its dependent claims 3 and 4), Applicants respectfully traverse the rejection because the cited reference does not disclose or suggest a magnetic disk device having a wind shield with a curved guide surface for guiding airflow to outside of the disk. Against these claims, the Examiner has stated an improper *prima facie* case of obviousness against this feature of the claim under Section 2143.03 of the MPEP. Section 2143.03 requires of the Examiner, when asserting his *prima facie* case of obviousness, to first establish where in the cited prior art reference all of the claim features and limitations are taught or suggested. In the present case, however, the Examiner has not done so.

Specifically, the Examiner even acknowledges on page 2 of Paper No. 10 that “Ekhoﬀ does not expressly state that the wind shield members have an air entrance side edge curved guide surface for guiding the air flow to the outside of the disks.” Applicants further note that the Examiner does not even assert that Ekhoﬀ instead suggests such a specific structural configuration as is cited in claim 1 of the present invention. On the contrary, the

Examiner states that these unique features of the present invention must be obvious from the teachings of Ekhoﬀ alone, because Ekhoﬀ's air dams 10 perform a similar function as the improved wind shields of the present invention, namely, controlling air flow to the outer edge of the disks. This rationale by the Examiner, however, fails to fulfill the requirements of Section 2143.03.

Applicants do not dispute that Ekhoﬀ's air dams 10 control air flow to the edges of the spinning disks. Claim 1 of the present invention, however, does not merely recite only this function. In actuality, claim 1 additionally recites a specific and improved structural configuration to the wind shields of the present invention, that advantageously control the flow of air to the outside of the spinning disks in a manner superior to that of the more basic air dams 10 taught by Ekhoﬀ. The unique structural configuration presented in claim 1 is clearly recited in the claims of the present invention, and the Examiner has not cited to anywhere in Ekhoﬀ where may be found such a configuration. Section 2143.03, on the other hand, requires that the Examiner do so in establishing his *prima facie* case of obviousness. Before justifying the *motivation* to combine the several features that are recited in claim 1 of the present invention, the Examiner must first establish where all such features are taught or suggested in the prior art. Again, in this case, the Examiner simply has not done so.

To establish obviousness based on a single reference only, the Examiner must show that the recited features of the present invention are either taught or suggested in the

reference itself, or otherwise that the claimed features must be somehow *inherent* to the teachings of that reference. Neither possibility though, applies to the present rejection based on Ekhoﬀ.

The Examiner acknowledges that Ekhoﬀ does not state the recited structural configuration of claim 1 of the present invention. Applicants also note that the Examiner has not stated that such a configuration must be inherent to Ekhoﬀ either. In fact, the unique structural configuration of the wind shields of the present invention could not be inherent to Ekhoﬀ, because Ekhoﬀ specifically teaches a *different* structural configuration, namely, that of straight edges to its guide arm only. The motivation suggested by the Examiner for adapting the unique structural configuration of the present invention to the teachings of Ekhoﬀ, is therefore irrelevant where the cited reference fails to actually teach or suggest such a unique feature. Accordingly, for at least these reasons, the Section 103 rejection of claims 1 and 3-4 based solely on Ekhoﬀ is respectfully traversed, and should be withdrawn.

With respect to claim 8 (and its dependent claim 9), Applicants respectfully traverse because Ekhoﬀ fails to teach or suggest the newly recited inner side features now recited in amended claim 8. Applicants here note for the record that these newly recited features of claim 8 were discussed in the Remarks of Amendment A, filed October 6, 2003, but also that Applicants inadvertently neglected to amend claim 8 to recite such features. The newly recited features are therefore those which were referred to in Amendment A. Applicants respectfully submit that Ekhoﬀ fails to teach or suggest such structural features,

and that claims 8 and 9 are allowable over the outstanding Section 103 rejection based on Ekhoﬀ.

Claims 1, 3-4, and 8-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (U.S. 5,134,530) in view of Ekhoﬀ. Applicants respectfully traverse this rejection for at least the reasons discussed above, and as follows.

The Examiner specifically acknowledges on page 3 of Paper No. 10 that Hall does not state that wind shield members have an air entrance side edge curved guide surface for guiding the air flow to the outside of the disks. The Examiner appears to instead imply that the curved wind shields of the present invention are somehow taught by Ekhoﬀ. As discussed above, however, the Examiner has already acknowledged that Ekhoﬀ teaches no such features. Accordingly, this Section 103 rejection also fails to meet the clear requirements of Section 2143.03 of the MPEP, and should therefore be withdrawn.

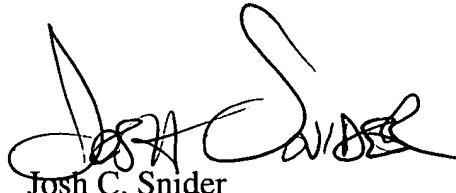
The Examiner does at one point on page 3 of Paper No. 10 state that “Ekhoﬀ discloses that wind shield members may be curved.” The Examiner, however, provides no support for this broad assertion. Neither cited reference teaches or suggests any curved guide surface to the rotational entrance side of a wind shield, as featured in the present invention. Ekhoﬀ in particular shows only straight edges to the rotational entrance sides of its air dams 10. (See Figs. 2, 5). In fact, every vertical view of the air dams 10 shown by Ekhoﬀ (Figs. 2, 5) shows only straight edges. And, although Ekhoﬀ does teach that other shapes or configurations of the fingers 42 of the air dams 10 are possible (see col. 5, lines 51-52), no

For all of the foregoing reasons, Applicants submit that this Application, including claims 1 and 3-9, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

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April 8, 2004

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example of the different shapes suggested by Ekhoﬀ (col. 5, lines 53-62) even suggests that the edge on the rotational entrance side of the air dam 10/finger 42 is anything other than straight.

The only curve even shown by Ekhoﬀ is the U-shaped finger 65 shown in Fig. 4. Applicants point out, however, that the bend of the U-shaped finger 65 shown is not the edge on the rotational entrance side, but instead a different edge *perpendicular* to the edge on the rotational side. The edge on the rotational side of Ekhoﬀ's air dams cannot be seen in the sectional view of Fig. 4, but only in the vertical views of Figs. 2 and 5. Accordingly, for at least these reasons, the rejection of claims 1 and 3-4 based on a combination of Hall and Ekhoﬀ is traversed, and should be withdrawn.

With respect to claims 8 and 9 of the present invention, Applicants respectfully traverse the rejection for at least the reasons discussed above, and in light of the amendments made to claim 8 herein. Like Ekhoﬀ, Hall shows only straight inner sides to its air strippers 20. Neither Hall nor Ekhoﬀ teaches or suggests any inner side to a wind shield that faces the center of the disks that can be measured radially. In other words, neither Hall nor Ekhoﬀ teaches or suggests a curved inner side. Accordingly, the rejection of claims 8 and 9 is also respectfully traversed.